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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,968	01/23/2004	Jeffrey C. Smith	P-2127 CON	7903

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PATENT DEPARTMENT  
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EXAMINER

KLIMACH, PAULA W

ART UNIT PAPER NUMBER

2135

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,968

Applicant(s)

SMITH ET AL.

Examiner

Paula W. Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

<b>Patent 6725381 B1</b>	<b>Application 10763968</b>
I Claim 1. A method for authenticating a first user for a data transmission transaction over a server system between the first user and a second user wherein the second user has identified the first user, the method comprising:	I Claim 1. A method for authenticating a first user for a data transaction between the first user and a second user wherein the second user has identified the first user, the method comprising:
II a server receiving authentication information from the second user;	II receiving authentication information from the second user;

III the server prompting the first user to submit the authentication information; and	III prompting the first user to submit the authentication information;
IV the server receiving response information to the authentication information;	IV receiving response information from the first user responsive to the prompting;
V the server comparing the response information to the authentication information; and	V comparing the response information to the authentication information; and
VI the server authenticating the first user upon a condition in which the response information is equivalent to the authentication information.	VI authenticating the first user upon a condition in which the response information is equivalent to the authentication information.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6725381 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent 6725381 ('381) contains the limitation of the application 10763968 ('968), however in the element IV the application ('968) recites "receiving response information from the first user responsive to the prompting," while the patent ('381) recites "the server receiving response information to the authentication information." It is implicit that the response that is received in both system are the same response since in the element III of both systems it is the first user that

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is prompted for authentication information, therefore the response in the application ('968) is authentication information from the first user as in the patent ('381).

6725381 B1	Application
Claim 5. A method for a server authenticating a first user for a data transaction between the first user and a second user wherein the second user has identified the first user, the method comprising:	Claim 5. A method for authenticating a first user for a data transaction between the first user and a second user wherein the second user has identified the first user, the method comprising:
the server sending a message to the first user as identified by the second user;	sending a message to the first user as identified by the second user;
in a session with the first user in response to the message, the server receiving user account information from the first user;	in a session with the first user in response to the message, receiving user account information from the first user; and
the server generating transaction data associated with the first user the transaction data including security data for allowing the first user to proceed with said data transaction between the first user and a second user; and	

the server sending a second message to the first user as identified by the second user wherein the second message includes said transaction data which is necessary for proceeding with the data transaction	sending a second message to the first user as identified by the second user wherein the second message includes transaction data which is necessary for proceeding with the data transaction.
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Claim 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6725381 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 5 of the patent 6,725,381 discloses all the limitation as recited in claim 5 of the application (10763968).

Claim(s) 1 and 5 of Patent/Application # 6725381 contain(s) every element of claim(s) 1 and 5 of the instant application and thus anticipate the claim(s) of the instant application. Claim(s) of the instant application therefore is/are not patently distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousnesstype

double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner,

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778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4, 14-15, and 27-30** are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (6,898,577 B1).

*In reference to claims 1, 14, and 27* Johnson discloses a computer implemented draft authentication method for use in e-commerce includes the steps of establishing partner relationships between a financial institution and a plurality of World Wide Web (Web) vendors and storing, for each of a plurality of Web customers, at least one piece of unique identifying information linked to the Web customer's financial information linked to the Web customer's financial information (abstract). The system includes receiving authentication information from the second user, Bank, (column 10 lines 19-50); prompting the first user to submit the authentication information (column 9 lines 51-54); receiving response information from the first user, Web Customer, responsive to the prompting (column 9 lines 45-60); comparing the response information to the authentication information (column 10 lines 19-25); and

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authenticating the first user, Web Customer, upon a condition in which the response information is equivalent to the authentication information (column 10 lines 50-61).

*In reference to claims 2, 15, and 28* wherein prompting comprises: presenting to the first user prompt information which is received from the second user (column 10 lines 59-61).

*In reference to claims 3, 16, and 29* Johnson discloses a system wherein prompting comprises: in a session with the first user, receiving user account information from the first user (column 10 lines 58-67); sending identification data which identifies the first user as identified by the second user and the user account information to an information server (column 10 lines 19-25); and receiving verification data from the information server which indicates whether the information server contains an association between the identification data and the user account information (column 10 lines 59-61).

*In reference to claims 4, 17, and 30* further comprising: authenticating the first user upon a condition in which the information server contains the association (column 10 lines 41-65).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-13, 18-26, 31-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.



*In reference to claims 5, 11, 18, 24, 31, and 37* Johnson discloses a computer implemented draft authentication method for use in e-commerce includes the steps of establishing partner relationships between a financial institution and a plurality of World Wide Web (Web) vendors and storing, for each of a plurality of Web customers, at least one piece of unique identifying information linked to the Web customer's financial information linked to the Web customer's financial information (abstract). In a session with the first user in response to the message, receiving user account information from the first user (column 10 lines 55-67); and sending a second message to the first user as identified by the second user wherein the second message includes transaction data which is necessary for proceeding with the data transaction (column 11 lines 1-10).

Although Johnson discloses the Master list that identifies the first user (Web Customer) by the second user (Bank); Johnson does not expressly disclose sending a message to the first user.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to send a message to the web customer in the system of Johnson.. One of ordinary skill in the art would have been motivated to do this because it would simplify the use of the system when the user knows the status of the request to purchase mostly when the bank has not authenticated the web customer.

*In reference to claims 6, 19, 32* wherein the transaction data is a universal resource (column 10 lines 35-53).

*In reference to claims 7, 20, and 33* wherein the transaction data identifies the first user (column 11 lines 11-35).

*In reference to claims 8, 21, 34* wherein the transaction data identifies subject data of the data transaction (column 11 lines 15-20).

*In reference to claims 9, 22, 35* wherein the transaction data identifies subject data of the data transaction (column 11 lines 15-20).

*In reference to claims 10, 23, 36* further comprising: receiving the transaction data from the first user (column 11 lines 11-35); and proceeding with the data transaction in response to the transaction data (column 11 lines 1-11).

*In reference to claims 12, 25, and 38* Johnson discloses a system wherein prompting comprises: in a session with the first user, receiving user account information from the first user (column 10 lines 58-67); sending identification data which identifies the first user as identified by the second user and the user account information to an information server (column 10 lines 19-25); and receiving verification data from the information server which indicates whether the information server contains an association between the identification data and the user account information (column 10 lines 59-61).

Although Johnson discloses the Master list that identifies the first user (Web Customer) by the second user (Bank); Johnson does not expressly disclose sending a message to the first user.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to send a message to the web customer in the system of Johnson.. One of ordinary skill in the art would have been motivated to do this because it would simplify the use of the system when the user knows the status of the request to purchase mostly when the bank has not authenticated the web customer.

*In reference to claims 13, 26, and 39* further comprising: authenticating the first user upon a condition in which the information server contains the association (column 10 lines 41-65).

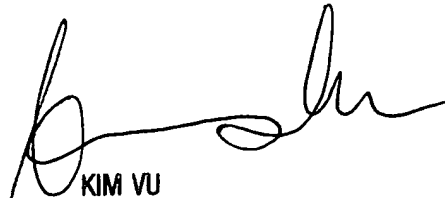
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PWK  
Saturday, October 28, 2006

  
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SUPERVISORY PATENT EXAMINER  
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